

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 63-66 were objected to for allegedly claiming the same subject matter as claims 54-61. Applicants respectfully traverse.

Claim 63 recites that the method comprises “. . . applying a mixture consisting of a polymeric binders . . .,” while claim 59 recites “. . . applying a mixture comprising a polymeric binder . . .” “Consisting of” is more restrictive than “comprising,” so the scope of the claims differ. In any event, none of the claims were allowed so the objection is premature. Withdrawal of this objection is requested.

With respect to the amount of inorganic pigment, the Examiner is referred to original claims 1-13 (not the Article 19 claims) which, e.g., in claim 1, do not provide any % wt for the pigment limitation. Also note that the mixture of the presently pending claims must contain other components in addition to the inorganic pigment, so the amount of inorganic pigment cannot be 100% by weight of the mixture. Clearly, a range of greater than 10 wt.% is disclosed and supported by the specification.

Claims 26, 28-31, 33-35, 46, 48-50 and 59-70 were rejected under 35 U.S.C. § 112, first paragraph, for reciting that the layer is electroconductive, which is allegedly not described in the specification in accordance with that statute. Applicants respectfully traverse.

The layer contains the electroconductive pigment to make the layer electroconductive as would be understood to one of skill in the art. Thus, it is believed that the specification does contain sufficient written description of the invention and the rejection should be withdrawn.

It is believed that the amendments to the claims overcome the remaining 34 U.S.C. §112, first paragraph rejection of the claims.

Claims 26, 28-31, 3-35, 46, 48-50 and 59-70 were rejected as allegedly obvious over Kulkarni in view of Odawa. Applicants respectfully traverse.

The Examiner acknowledges that Kulkarni does not disclose a coating comprising at least

10 wt. % or at least 20 wt. % of a conductive inorganic pigment, yet argues that it is not inventive to discover optimum variables by routine experimentation. Applicants suggest that based on the teachings of Sobata, one of skill in the art would certainly not have looked to a range below 30 wt. % or above 70 wt. %, i.e., they would have been lead away from the range of 10 or 20 wt. % to 40 wt. %. An objective reading of Sobata contradicts the Examiner's "routine experimentation" allegation.

Withdrawal of this rejection is respectfully requested.

Claims 26, 28-31, 33-35, 46, 48, 50, 60, 62, 64, 66, 68 and 69 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over the combination of Bristowe, Sobata and Kulkarni. Applicants respectfully traverse.

The deficiencies of the combination of Bristowe and Sobata are discussed above. Kulkarni does not overcome these deficiencies, and is cited for disclosing that organic coatings have long been used for corrosion protection due to their barrier properties, such as zinc rich coatings in layers as thin as 0.1 mil. In view of the foregoing, withdrawal of this rejection is respectfully requested.

Claims 26, 28-31, 33-35, 46, 48-50 and 59-70 were rejected as allegedly obvious over Kulkarni and Odawa in view of Sobata. Applicants respectfully traverse.

The deficiencies of the combination of Kulkarni and Odawa are noted above. Sobata is cited for disclosing that usually 15-86 wt % of electroconductive pigments are known in the art. However, the Examiner fails to cite the passages in Sobata, noted above, that teach away from the presently claimed range. Therefore, as Sobata has not been considered for its teaching as a whole, and has been improperly applied. Reconsideration and withdrawal of this rejection is respectfully requested.

In view of the foregoing, allowance is respectfully requested.

Applicants reserve the right to prosecute any and all presently unclaimed subject matter in related continuing applications.

Claims 26, 28-31, 33-35, 46, 48-50 and 59-70 were rejected as allegedly obvious over Kulkarni and Odawa in view of Sobata. Applicants respectfully traverse.

The deficiencies of the combination of Kulkarni and Odawa are noted above. Sobata is cited for disclosing that usually 15-86 wt % of electroconductive pigments are known in the art. However, the Examiner fails to cite the passages in Sobata, noted above, that teach away from the presently claimed range. Therefore, as Sobata has not been considered for its teaching as a whole, and has been improperly applied. Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 49, 59, 61, 63, 65, 67 and 70 were rejected under 35 U.S.C. § 103 as allegedly obvious over Bristowe. Applicants respectfully traverse.

Bristowe discloses a vinyl urethane resin made of a polyoxyalkylene bisphenol A, and does mention use of additives to change physical properties of the resin, including magnetizable iron oxide, but does not disclose electroconductive properties. Bristowe fails to disclose that the coating mixture comprises at least 10% of the conductive inorganic or at least 20% of the conductive inorganic material. Withdrawal of this rejection is respectfully requested.

Claims 49, 59, 61, 63, 65, 67 and 70 were rejected under 35 U.S.C. §103 as allegedly obvious over Bristowe in view of Sobata. Applicants respectfully traverse.

Sobata teaches at col 9, lines 29-33 that the spot-weldability can be improved by limiting the aromatic ring content of the binder resin to 0-50% (see col. 10, line 17). Examples of such resins are provided at lines Col. 10, 19-25. According to Sobata, if electrically conductive pigments are added in amounts below 30% or above 70% deleterious effects result (see col. 11, lines 44-45). Also, other components must be added in such coatings (see col 9, line 47-col 11). Thus, Sobata teaches away from using amounts less than 30% and amounts greater than 70% of electrically conductive pigments, and the claimed range of Applicants is, not therefore suggested by Sobata. Note that the presently claimed ranges have been amended to an upper limit of 40 wt.%.

Furthermore, it is submitted that there is no reason to add electrically conductive pigments to Bristowe's composition in the amounts described by Sobata, because Sobata teaches to minimize the aromatic ring content of the coatings to 0-50% and also to include a wax.

To the extent Sobata suggests urethane resins in col. 10, line 20, it is not believed that one

would choose to use the vinyl ester urethane of Bristowe, which is based on a based on a biphenyl-containing resin, based on Sobata's teaching to minimize the aromatic ring content in the molecule to 50% or less.

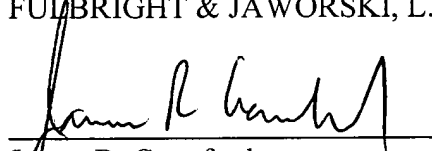
In view of the foregoing, withdrawal of this rejection is respectfully requested.

In view of the foregoing, allowance is respectfully requested.

Any fees due to enter this amendment or to maintain pendency of this application, authorization is given to charge deposit amount no. 50-0624.

Respectfully submitted,

FULBRIGHT & JAWORSKI, L.L.P.

A handwritten signature in black ink, appearing to read "James R. Crawford", is written over a horizontal line.

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